

## **REMARKS**

Claims 11, 30 and 49 have been amended. Claims 1-9, 11-18, 20-28, 30-37, 39-47 and 49-56 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Double Patenting Rejection:**

The Office Action provisionally rejected claims 1, 8, 9, 11, 17, 18, 20, 27, 28, 30, 37, 39, 47, 49 and 56 under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1, 12-15, 26-29 and 40-42 of co-pending Application No. 10/670,550 in view of Wick (U.S. Publication 2004/0093387) (hereinafter Wick), and claims 1, 8, 11, 17, 20, 27, 30, 39 and 49 over claims 1, 8-11, 18-21, 28, 29 and 30 of co-pending Application No. 10/670,549 in view of Wick. Applicant acknowledges the provisional rejection and will address it if and when it becomes non-provisional. Also, the Examiner's reliance on Wick is misplaced, as discussed in further detail below.

### **Section 102(e) Rejection:**

The Office Action rejected claims 11, 12, 14, 30, 31, 33, 49, 50 and 52 under 35 U.S.C. § 102(e) as being anticipated by Wick. While Applicant respectfully traverses this rejection, to expedite issuance of a patent, Applicant has amended independent claims 11, 30 and 49 for further clarity. Applicant submits that rejection of the amended independent claims would be unsupported by the cited references for at least the following reasons.

As amended, claim 11 requires the storing of an instant messaging operation associated with a specific presence state of an instant messenger, wherein the specific presence state associated with the received instant messaging operation is determined separately from a current presence state that is currently assigned to the instant

messenger. Moreover, claim 11 requires that the specific presence state be selected from a plurality of possible presence states other than a presence state that indicates only that a given user of the instant messenger is online. Additionally, claim 11 requires detecting a transition of said current presence state assigned to said instant messenger to said specific presence state subsequent to said storing, such that as a result of said transition, the specific presence state becomes visible to other users as indicative of said given user. Claim 11 further requires performing the instant messaging operation in response to this detecting.

Wick is directed to an instant messaging system that provides “pounce” functionality. To set up a pounce, the targeting user identifies the targeted user and identifies the event that triggers the pounce. Wick at [0040]. The only events Wick specifically discloses are “pouncee’s signing on to the system, pouncee’s sending an IM to a specified party, detection of being added to or deleted from the pouncee’s buddy list, etc.” *Id.* Once the pounce is set up, when the specified event occurs, the pounce is triggered. *Id.* at [0043]. In FIG. 8 and at [0049]-[0056], Wick provides further details regarding the parameters a targeting user may configured when setting up a pounce. The only triggering event that Wick discloses in this discussion is “on buddy signon.” That is, Wick only provides for performing a pounce when a user signs on to the system.

The only conditions of user activity Wick appears to distinguish are whether or not a user is signed in/online. However, amended claim 11 requires that the recited specific presence state be selected from a plurality of possible presence states other than a presence state that indicates only that a given user of an instant messenger is online. Because Wick does not disclose any aspect of a user’s status other than whether the user is online, Wick cannot disclose a specific presence state that is selected from possible presence states other than a state that indicates only online status.

Additionally, Wick fails to disclose detection of transitions in presence states in the manner required by claim 11. Wick does not directly discuss any aspect of either presence states or their detection. The Office Action alleges that Wick’s detecting an

occurrence of a user signing on discloses the recited detecting of a transition of a current presence state assigned to an instant messenger to a specific presence state. However, merely detecting that a user has signed on to an instant messenger does not entail any conclusion as to what the user's presence state is as a result of signing on. For example, it is well known that numerous instant messengers allow a user to sign on, and yet appear to be offline to other users. Thus, it is not inherent in the act of signing on that a user's presence state necessarily transitions to any particular presence state. Because Wick does not expressly disclose detecting a transition in a presence state as required by claim 11, and because this limitation is not inherent in Wick's discussion of a user's signing on to an instant messenger, Wick fails to disclose this feature either explicitly or implicitly.

Similar arguments apply to independent claims 30 and 49, which have been amended to recite at least some features that are similar to independent claim 11. For at least the foregoing reasons, Applicant submits that Wick fails to disclose all of the features of amended claims 11, 30, and 49. Applicant is unable to identify language in the remaining cited references that remedy the omissions of Wick. Accordingly, Applicant submits that the cited references would not support rejection of these claims.

### **Section 103(a) Rejections:**

The Office Action rejected claims 13, 15, 17, 32, 34, 36, 51, 53 and 55 under 35 U.S.C. § 103(a) as being unpatentable over Wick in view of Horvitz (U.S. Publication 2002/0087649), claims 16, 35 and 54 as being unpatentable over Wick in view of Cristofalo et al. (U.S. Publication 2002/0152117) (hereinafter "Cristofalo"), claims 18, 37 and 56 as being unpatentable over Wick in view of Horvitz (U.S. Publication 2008/0104517) (hereinafter "Horvitz '517"), claims 1-3, 5, 7, 20-22, 24, 26, 39-41, 43 and 45 as being unpatentable over Wick in view of Seshadri et al. (U.S. Patent 7,209,916) (hereinafter "Seshadri"), claims 4, 23 and 42 as being unpatentable over Wick and Seshadri in view of Cristofalo, claims 6, 25 and 44 as being unpatentable over Wick and Seshadri in view of Beyda (U.S. Publication 2003/0229722), claims 8, 27 and 46 as being unpatentable over Wick and Seshadri in view of Horvitz, and claims 9, 28 and 47 as

being unpatentable over Wick and Seshadri in view of Horvitz '517. Applicant respectfully traverses these rejections for at least the following reasons.

Regarding claim 1, the cited references fail to disclose or suggest, either individually or in any combination, all of the recited features. Specifically, the cited references fail to disclose or suggest receiving an instant messaging operation directed to a given user, wherein said instant messaging operation is associated with a specific presence state of an instant messenger, and wherein the specific presence state associated with the received instant messaging operation is determined separately from a current presence state that is currently assigned to the instant messenger. The cited references further fail to disclose or suggest determining whether the current presence state that is currently assigned to said instant messenger matches the specific presence state associated with the received instant messaging operation, wherein said current presence state corresponds to said given user, and in response to determining that said specific presence state of the received instant messaging operation matches said current presence state assigned to said instant messenger, performing said instant messaging operation.

In the Office Action, the Examiner contends that Wick discloses each of the foregoing. Office Action at 20. Applicants respectfully disagree. As noted above with respect to claim 11, although Wick discloses a distinction between whether a user is online or offline, this does not itself amount to a disclosure of a presence state or of a transition in a presence state, because a presence state is a distinct entity from a user's online status. That is, although a presence state may be capable of indicating online/offline status, it does not necessarily do so, because a user may be online while a presence state indicates an offline status. Because Wick presence state is not identical to or inherent in online/offline status distinctions, and because Wick discloses only the latter, Wick fails to disclose the presence states recited in claim 1.

Moreover, claim 1 requires (1) that a specific presence state be associated with a received instant messaging operation, and (2) a determination whether a current presence state currently assigned to an instant messenger matches the specific presence state.

Wick discloses that a pounce is queued pending occurrence of a specified event. Wick at [0041]. As noted above, Wick lists only three types of such events, including “pouncee’s signing on to system.” *Id.* at [0040]. Then, “upon occurrence of the specified event, the pounce is executed.” *Id.* at [0043] (emphasis added). That is, Wick discloses that the occurrence of the event alone is sufficient to trigger the pounce, and the only relevant event disclosed by Wick is the user signing on to the system.

But this differs from the requirements of claim 1. Claim 1 specifically recites that there is a determination regarding whether a current presence state of an instant messenger matches the specific presence state that is associated with a received instant messaging operation. This determination is an antecedent condition of performing the instant messaging operation. In Wick, there is no determination of whether a current presence state matches a specific presence state. Indeed, Wick does not disclose that any particular presence state is associated with a queued pounce. Thus, Wick cannot be said to determine whether there is a match of presence state, and then in response to determining that there is such a match, perform the instant messaging operation, as required by claim 1. Instead, in Wick, the occurrence of a user sign-in event is unconditionally sufficient to cause the queued pounce to be executed. Nothing more is required, unlike in claim 1.

Similar arguments apply to independent claims 20 and 39, which recite at least some features that are similar to independent claim 1. For at least the foregoing reasons, Applicant submits that Wick fails to disclose all of the features of independent claims 1, 20, and 39. Applicant is unable to identify language in the remaining cited references that remedy the omissions of Wick. Accordingly, Applicant submits that the cited references fail to support rejection of these claims.

In regard to all the rejections, Applicant submits that the rejections of various ones of the dependent claims are further unsupported by the cited references. However, as the rejections of the independent claims have been shown to be unsupported, further discussion of the dependent claims is unnecessary at this time.

## CONCLUSION

Applicants submit the application is in condition for allowance, and an early notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-69900/RCK.

Respectfully submitted,

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